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FEB 12 2001

U.S. PATENT OFFICE

GROUP 1638

Examiner A. K. Rabeli

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RESPONSE

Washington, D.C. 20231

Responsive to the restriction requirement imposed in the Official Action of January 12, 2001, applicants hereby provisionally elect Group II, claims 1, 3 and 5, drawn to use of a plant with nuclear male sterility for avoiding dissemination of a transgene, with traverse. The grounds for a traverse are as follows:

Recognizing that the present application is the U.S. national stage of a PCT International application, the Official Action initially attempts to apply PCT Rule 13 in support of the restriction requirement. In this regard, we note that claims of the same scope were presented during the International Phase of the present PCT application, and, during the International Phase, no lack of unity of invention was found. Therefore, the present restriction requirement, at a minimum, should seek to explain why the International Examiner is believed to have been mistaken; however, no such explanation is provided. Moreover, the fact that all of the

present claims were searched during the International Phase means that the present Examiner cannot now contend that any undue searching burden would be posed by examining all of claims 1-12 in the present application.

The substance of the newly-formulated argument for restriction under PCT Rule 13 is that ODELL et al. (WO 91/09957) describes "the application of the loxP-cre recombination system for controlling male fertility, which would avoid dissemination of transgenes."

However, that contention is incorrect. In fact, ODELL et al. merely teaches the use of the loxP-cre technology to allow restoration of fertility in hybrid crops. There is no mention of dissemination of transgenes.

OLIVER et al. (WO 96/04393) likewise does not disclose or suggest the common core of the present claims, as it does not suggest to use male-sterile plants for avoiding dissemination of a transgene. Indeed, none of the cited prior art documents discloses the concept of dissemination of transgenes that link the groups of the invention.

Consequently, a correct analysis under PCT Rule 13 does not recommend any restriction among claims 1-12, as the cited prior art does not evidence the lack of a "special technical feature", even according to the art-based definition of that term in PCT Rule 13.2.

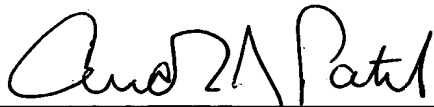
~~The remainder of the restriction requirement seeks~~
to justify restriction under the vague concept of "unrelated inventions", as mentioned in MPEP Chapter 800. That standard,

which is questionable in any context, cannot as a matter of law be applied to the national stage of a PCT International application. According to *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D.Va. 1986), any rule or interpretation by the USPTO concerning a restriction requirement that conflicts with the PCT, would constitute a violation of PCT Article 27. Consequently, as the present restriction requirement is improper under the standards of PCT Rule 13, as explained above, there is by definition no provision of the MPEP that could confer propriety to the requirement.

From the above discussion, it is believed to be apparent that the restriction requirement must be withdrawn, and that all of claims 1-12 be examined in the present application, in the full scope claimed. Such action is accordingly respectfully requested.

Respectfully submitted,

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February 12, 2001